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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048777
Party	Defendant Michael Calmese
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Submission	Response to Board Order/Inquiry
Filer's Name	Michael Calmese
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Date	09/20/2010
Attachments	TTAB_Notice_Cancellation_No_92048777.pdf (8 pages)(125296 bytes)

Adidas America, Inc., a Delaware Corporation,)	
Petitioner,)	Cancellation No.: 92048777
)	Registration No.: 2,202,454
-against-)	Registration Date: November 10, 1998
)	Mark: PROVE IT!
Michael D. Calmese, a resident of Arizona,)	
Respondent)	
)	

RESPECTFULLY SUBMITTED this 20th day of September, 2010

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing was forwarded on this the 20th day of September, 2010, addressed as follows:

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/Michael Calmese/

EXHIBIT A.

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON
PORTLAND DIVISION**

ADIDAS AMERICA, INC.,

Plaintiff,

**08-CV-91-ST
ORDER**

v.

MICHAEL CALMESE,

Defendant.

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Defendant, *Pro Se*

BROWN, Judge.

On June 25, 2010, the Court heard oral argument on pending motions and made the following Rulings and Orders :

1. With respect to Plaintiff's Memorandum in Support of Plaintiff's Position that the Sole Remaining Claim Should be Tried to the Court (#187), the Court acknowledges Defendant Calmese's request for a jury trial . The Court, however , concludes Plaintiff's sole remaining claim seeking cancellation of Defendant Calmese's trademark under the Lanham Act , 15 U. S . C. § 1119 is an equitable claim for which Defendant does not have a right to a jury trial . Section 1119 expressly provides "the court may determine" whether to cancel a trademark. Although the Ninth Circuit has not directly addressed the equitable nature of a claim under § 1119 , other courts have addressed this issue. In *Empresa Cubana Del Tabaco v. Culbro. Corp.*, the Southern District of New York held "A claim for cancellation of a trademark registration pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, is

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equitable in nature and does not give rise to a jury trial right ." 123 F. Supp. 2d 203, 209 (S. D.N.Y. 2000). See also *Patsy's Italian Restaurant, Inc. v. Banas*, 575 F. Supp. 2d 427, 452 (E.D.N.Y. 2008) (describing the Court's authority under § 1119 as "quintessentially equitable"); *Avon Shoe Co. v. David Crystal, Inc.*, 171 F. Supp. 293, 302 (D.C.N.Y.1959). Moreover, the Supreme Court has described the district courts' authority under that portion of the Lanham Act as equitable. *Park 'n Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 , 203 - 04 (1985) . In addition, 15 U.S.C. § 1120 provides a separate legal remedy for anyone damaged by the procurement of a fraudulent trademark registration , and Plaintiff does not seek damages under that provision . For these reasons, the Court concludes an action pursuant to § 1119 is an equitable action and is not subject to the constitutional right to trial by jury.

2. With respect to Plaintiff's Motion (#196) for Leave to Lodge a Separate Proposed Pretrial Order, the Court, in the exercise of its case management responsibilities, relieves the parties of the obligation to file a pretrial order. Plaintiff's Motion, therefore, is **DENIED as moot**.

3. With respect to Defendant's Motion (#194) to Suppress, the Court **DENIES** Defendant's Motion with leave to renew specific objections to the use of his deposition at trial. Plaintiff is directed to provide Defendant with notice of the portions of Defendant's deposition it intends to rely on as admissions of a party in its case-in- chief at trial . Plaintiff should be prepared to authenticate at trial all parts of Defendant's deposition that Plaintiff seeks to use at trial for any purpose.

The Court also sets the following case management deadlines:

1. The parties shall have made all required expert witness disclosures, including the expert's qualifications, a summary of his or her opinions , and the bases for such opinions, no later than August 6, 2010.
2. Plaintiff shall provide Defendant with a list of anticipated trial witnesses (including a brief summary of each witness 's expected testimony) and a list of proposed exhibits no later than August 23, 2010. Defendant must provide the same material to Plaintiff no later than September 13, 2010. The parties must provide advanced notice in these exchanges of any witnesses who the party proposes should be permitted to testify remotely.

3. The parties may file no later than October 8, 2010, motions *in limine* outlining any objections to the opponent's proffered witnesses and exhibits.
4. No later than October 8, 2010, the parties shall file trial memoranda not to exceed 15 pages that set out the relevant factual and legal issues for trial as well as the applicable legal standards to resolve all remaining disputes in this matter.
5. No later than October 15, 2010, the parties may file responsive supplemental trial memoranda that are no longer than 5 pages.
6. Trial to the Court is set for 9 a.m. on November 2, 2010, in Courtroom 14A in Portland, Oregon, and will continue daily thereafter until concluded or as the Court may order. The Court will not hold a pretrial conference.

IT IS SO ORDERED.

DATED this 29th day of June, 2010.

ANNA J. BROWN

United States District Judge